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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,344	01/16/2002	Erich William Gerbsch	DP-302230	6227

7590 01/26/2004

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT	PAPER NUMBER
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2826

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AL

Office Action Summary	Application No. 10/050,344	Applicant(s) GERBSCH ET AL.	
	Examiner Alexander O Williams	Art Unit 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,9 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Serial Number: 10/050344 Attorney's Docket #: DP-302230
Filing Date: 1/16/2002;

Applicant: Gerbsch

Examiner: Alexander Williams

Applicant's election of species I, figures 2, 3a and 3b (claims 1 to 3, 5, 6, 8 and 10), filed 11/12/03, has been acknowledged. The Examiner notes that claim 9 would not be a part of elected species, however, will be examined if claim 1 become allowable since claim 1 is generic to claim 9. Applicant's statement stating "Applicant further requests that the claims of Species II and III be cancelled without prejudice" was improper in formally canceling the non-elected claims. A proper amendment should cancel the desired claims.

This application contains claims 4, 7, 9 and 11 to 13 drawn to an invention non-elected without traverse.

The use of the trademark "SO"; "TO220"; and "TO227" packages have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, it is unclear and confusing to what is meant by "a TO220 device."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3, 5, 8 and 9, **insofar as claim 9 can be understood**, are rejected under 35 U.S.C. § 102(b) as being anticipated by Kaufman (U.S. Patent # 4,902,854).

1. Kaufman (figures 1 to 10) specifically figures 1 and 2 show a pre-packaged component device comprising:
a first non-conductive substrate member **36** having an outer surface; a second non-conductive substrate member **28** having an outer surface; a first layer of solderable electrically conductive material **34** secured to the outer surface of said first non-conductive substrate member; a second layer of solderable electrically conductive material **30** secured to the outer surface of said second non-conductive substrate member; and lead members **20,22,24** and a transistor member **38** positioned between said first and second non-conductive substrate members, said transistor having at least one gate **56**.
2. The component device as recited in claim 1, Kaufman show wherein said first and second non-conductive substrate members are made from a ceramic material.
3. The component device as recited in claim 2, Kaufman said wherein said ceramic material is taken from the group consisting of alumina, aluminum nitride, silicon nitride, and beryllium oxide.
5. The component device as recited in claim 1, Kaufman show wherein said lead members comprise a gate pin, a drain member and a source member.
8. The component device as recited in claim 1, Kaufman show wherein said transistor member is a MOSFET.
10. The component device as recited in claim 1 Kaufman show wherein said component device is a T0220 device.

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Initially, and with respect to claim 6, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufman (U.S. Patent # 4,902,854).

6. The component device as recited in claim 5, Kaufman show wherein said lead members are stamped from a copper material during manufacture.

As to the grounds of rejection under section 103, see MPEP § 2113.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/666,692,691,728,732,578,584 174/52.4	1/18/04
Other Documentation: foreign patents and literature in 257/666,692,691,728,732,578,584 174/52.4	1/18/04
Electronic data base(s): U.S. Patents EAST	1/18/04

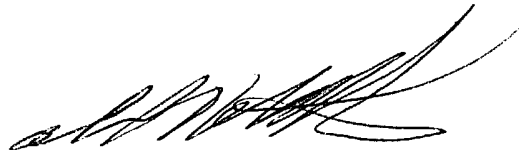
Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.

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Any inquiry concerning this communication or any earlier communication from the examiner should be directed to **Examiner Alexander Williams** whose telephone number is **(703) 308-4863**.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 receptionist** whose telephone number is **(703) 308-0956**.

1/20/04

A handwritten signature in black ink, appearing to read 'Alexander O. Williams', with a stylized, flowing script.

Primary Patent Examiner
Alexander O. Williams